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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,145	05/23/2000	Paul Lapstun	NPA035US	9217

24011 7590 08/18/2004

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EXAMINER	
PHAM, THIERRY L	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/575,145	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Thierry L Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. An updated status of the applications cited on page 1 of the specification is required (i.e. patent number if the application have already been issued).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 9-10, 14, 18-22, 24-25, 29, 31-32, 34, 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Tabata et al (U.S. 6537324).

Regarding claim 1, Tabata discloses a method for printing a digital photograph (i.e. medium form 201 of fig. 2 includes photographic image) including the following steps:

(a) transmitting (transmitting via a network, fig. 1) instruction for printing the photograph to a printer;

(b) printing the photograph (graphic dicon, fig. 2) onto a surface using the printer (printer 40, fig. 1);

(c) also printing on the surface coded data (coded data 206, fig. 2, cols. 9-10) indicative of an identity of the photograph (coded data contains linkage information and document identifying information, cols. 6, lines 10-67) and at least one reference point on the surface, wherein the coded data is printed on the surface in a form which can be read by an optical sensing device (optical reader 60 for reading coded data, fig. 1, cols. 6, lines 58-67 to col. 7, lines 1-20 and cols. 9-10).

Regarding claim 2, Tabata further discloses a method according to claim 1 wherein the identity of the photograph is determined by an identification code issued by a server (file server 20, fig. 1) which issues photograph identification codes (URL encoded data, fig. 2, cols. 13-14).

Regarding claim 3, Tabata further discloses a method according to claim 1 wherein a copy of the photograph may be requested by directing an optical sensing device towards a zone (code area 206, fig. 2) on the surface, which causes the optical sensing device to sense coded data on the surface and transmit a message to a printer (fig. 20, cols. 13-14), which in turns causes the printer to print a copy of the photograph (graphic dicon, col. 9, lines 25-30).

Regarding claim 4, Tabata further discloses a method according to claim 1 wherein a digital copy of the photograph is archived separately from the printed photograph and the original digital photograph (cols. 9-10).

Regarding claim 9, Tabata further discloses a method according to claim 1 wherein data indicative of an action is forwarded from an optical sensing device to a printer (fig. 20) when the optical sensing device is used to designate a particular zone of the surface.

Regarding claim 10, Tabata further discloses a method according to claim 1 wherein the surface has printed on it one or more options which a user may select, each associated with a designated zone on the surface, and the user selects an option by moving an optical sensing device on the surface within the associated zone (zone within the medium form, fig. 2), the optical sensing device transmitting data indicative of the user's selection to a printer (fig. 14-19).

Regarding claim 14, Tabata further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed by directing an optional sensing device to a zone on the surface (optical scanner for scanning zones with in medium form, fig. 2).

Regarding claim 18, the printer automatically binds the pages together are widely known in the art.

Regarding claims 19-22, 24-25, 29, 31-32, 34, 38 recite limitations that are similar and in the same scope of invention as to those in claims 1-4, 9-10 and 14 above; therefore, claims 19-22, 24-25, 29 are rejected for the same rejection rationale/basis as described in claims 1-4, 9-10 and 14.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 11-13, 26-28, 33, 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata as described in claim 1 above, and in view of Wolff et al (U.S. 6081261).

Regarding claim 11, Tabata does not explicitly disclose wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movements of the optical sensing device being transmitted to a printer and converted to computer text.

Wolff, in the same field of endeavor for coded sensing device, teaches wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movements of the optical sensing device being transmitted to a printer and converted to computer text (fig. 6, abstract and cols. 4-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Wolff because of a following reason: (1)

provides a sensing instrument that is capable of sensing coded data and writing entries on documents/images.

Therefore, it would have been obvious to combine Tabata with Wolff to obtain the invention as specified in claim 11.

Regarding claim 12, Wolff further discloses wherein a user signs the photograph by writing the user's signature on the surface with an optical sensing device, data indicative of the movement of the optical sensing device being transmitted to a printer, the signature thereafter being verified by comparison with a known signature of the user (signature verification, col. 2, lines 55-67).

Regarding claim 13, Wolff further discloses wherein a user draws on the photograph by drawing on the surface with an optical sensing device, data indicative of the movements of the optical sensing device being transmitted to the printer (abstract and cols. 6-7).

Regarding claims 26-28, 33, 39-41 recite limitations that are similar and in the same scope of invention as to those in claims 11-13; therefore, claims 26-28, 33, 39-41 are rejected for the same rejection rationale/basis as described in claims 11-13.

6. Claims 15-17, 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata as described in claim 1 above, and in view of Dymetman et al (U.S. 6330976).

Regarding claims 15-17, Tabata does not explicitly disclose wherein the coded data is printed using an infrared and/or an infrared-absorptive ink that is invisible to the human eye.

Dymetman, in the same field of endeavor for printing coded data on the medium, teaches where the coded data is printed using an infrared ink and/or infrared-absorptive ink (cols. 11, lines 45-67 to col. 12, lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Dymetman because of a following reason: (1) the contents of the printed image will not be distorted and/or deteriorated, and such coded data can be only read by optical reader.

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claims 15-17.

Regarding claims 42-44 recite limitations that are similar and in the same scope of invention as to those in claims 15-17; therefore, claims 42-44 are rejected for the same rejection rationale/basis as described in claims 15-17.

7. Claims 5-8, 23, 30, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata as described in claim 1 above, and in view of McIntyre et al (U.S. 6102505).

Regarding claim 5, Tabata teaches limitations (b) through (e) (see claim 1 above for more details), but does not teach a photograph is taking using a digital camera.

McIntyre, in the same field of endeavor for coded data, teaches a digital camera for taking digital photograph images (digital camera, fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of McIntyre because of a following reason: (1) a digital camera which allows operator to take digital images and encrypted with barcodes.

Therefore, it would have been obvious to combine Tabata with McIntyre to obtain the invention as specified in claim 5.

Regarding claims 6-7, the combinations of Tabata and McIntyre further teaches wherein the digital camera and printer form an integrated unit (fig. 1, col. 2, lines 55-67, McIntyre), the step of transmitting the digital photograph is done by means of a transmitter (network, fig. 1, Tabata) located in or proximate the integrated unit, the step of assigning an identification code is conducted on a computer (barcode is assign via file server and/or printer server, col. 6, lines 26-45) remote from the integrated unit, and the identification code is transmitted from the remote computer to the integrated unit before the digital photograph is printed (fig. 20, Tabata).

Regarding claim 8, the photograph identification code is also sent to a digital camera which took the photograph for future reference (image took by camera is also encrypted with barcodes, cols. 4, lines 50-67).

Regarding claims 23, 30, 35-37 recite limitations that are similar and in the same scope of invention as to those in claims 5-8; therefore, claims 23, 30, 35-37 are rejected for the same rejection rationale/basis as described in claims 5-8.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) U.S. 6529522 to Ito, teaches a digital camera communicating with printer via a wireless and/or wired network.

(2) U.S. 6137590 to Mori, teaches a method for printing an identification code on the images to identify images.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

TP

GABRIEL GARCIA
PRIMARY EXAMINER